

The law is clear that anticipation requires that a single prior art reference disclose each and every limitation of the claim sought to be rejected. 35 U.S.C. § 102(b).

In an effort to expedite prosecution, and without admission that any amendment is necessary, the Applicant has amended independent claim 1 to more clearly distinguish the claimed invention over the cited art. Among other things, independent claim 1 recites that the exterior rear view mirror includes an electric motor having an output shaft selectively operable to cause angular movement of the housing about the first pivot axis at a first discrete speed and at a second discrete speed, and a controller adapted to control the electric motor so as to selectively drive the housing about the first axis either at the first speed or at the second speed which is faster than the first speed.

Enomoto et al. ('693) teaches no such structure.

Accordingly, the Applicant contends that the 35 U.S.C. § 102(b) rejection of claim 1 has been overcome.

Additionally, claim 1 is not rendered obvious by Enomoto et al. ('693).

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989). There must be a teaching in the prior art for the proposed combination or

modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

As previously noted, independent claim 1 recites, among other things, that the exterior rear view mirror includes an electric motor having an output shaft selectively operable to cause angular movement of the housing about the first pivot axis at a first discrete speed and at a second discrete speed, and a controller adapted to control the electric motor so as to selectively drive the housing about the first axis either at the first speed or at the second speed which is faster than the first speed.

There is no suggestion by Enomoto et al. ('693) that the mirror housing can be moved about an axis at first and second discrete, i.e., different, speeds.

Accordingly, claim 1 is not rendered obvious by Enomoto et al. ('693).

Rejection of Claims 1-3 Under 35 U.S.C. § 102(e)

Claims 1-3 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Valentino ('167).

The Applicants respectfully traverse the 35 U.S.C. § 102(e) rejection of claims 1-3.

The law is clear that a person shall be entitled to a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent. 35 U.S.C. § 102(e).

The law is also clear that a claim in dependent form shall be construed to incorporate all the limitations of the claim to which it refers. 35 U.S.C. § 112 ¶ 4.

In an effort to expedite prosecution, and without admission that any amendment is necessary, the Applicants have amended independent claim 1 to more clearly distinguish the claimed invention over the cited art. Among other things, independent claim 1 recites that the exterior rear view mirror includes an electric motor having an output shaft selectively operable to cause angular movement of the housing about the first pivot axis at a first discrete speed and at a second discrete speed, and a controller adapted to control the electric motor so as to selectively drive the housing about the first axis either at the first speed or at the second speed which is faster than the first speed.

Valentino ('167) teaches no such structure.

Accordingly, the Applicants contend that the 35 U.S.C. § 102(e) rejection of claims 1-3 has been overcome.

Additionally, claims 1-3 are not rendered obvious by Valentino ('167).

There is no suggestion by Valentino ('167) that the mirror housing can be moved about an axis at first and second discrete, i.e., different, speeds.

Accordingly, claims 1-3 are not rendered obvious by Valentino ('167).

Rejection of Claims 6-7 Under 35 U.S.C. § 103(a)

Claim 6-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Enomoto et al. ('693) in view of Tomiyoshi ('030).

The Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 6-7.

Because independent claim 1 is allowable over Enomoto et al. ('693) for the reasons stated above, claims 6-7, which are dependent on claim 1, are likewise allowable. Tomiyoshi ('030) does not cure the deficiencies in the teachings of Enomoto et al. ('693).

Accordingly, the Applicants contend that the 35 U.S.C. § 103(a) rejection of claims 6-7 has been overcome.

Rejection of Claims 4-5 Under 35 U.S.C. § 103(a)

Claim 4-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Valentino ('167) in view of Tomiyoshi ('030).

The Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 4-5.

Because independent claim 1 is allowable over Valentino ('167) for the reasons stated above, claims 4-5, which are dependent on claim 1, are likewise allowable. Tomiyoshi ('030) does not cure the deficiencies in the teachings of Valentino ('167).

Accordingly, the Applicants contend that the 35 U.S.C. § 103(a) rejection of claims 4-5 has been overcome.

Objection to the Drawings

The drawings stand objected to because element (30), disclosed on page 2 of the specification, has not been properly labeled.

The Applicants submit herewith a Request for Approval of Drawing Changes that corrects the above-referenced oversight. The Applicants aver that no new matter has been introduced into the specification or drawings by virtue of this correction.

Accordingly, the Applicants contend that the objection to the drawings has been overcome.

Conclusion

It is respectfully submitted that the claims, as amended, are patentably distinguishable because the cited patents, whether taken alone or in combination, do not teach, suggest or render obvious, the present invention. Therefore, applicant submits that the pending claims are properly allowable, which allowance is respectfully requested.

The Examiner is invited to telephone the applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Please send all future correspondence relating to this application to Warn, Burgess & Hoffmann, P.C., P.O. Box 70098, Rochester Hills, MI 48307.

Respectfully submitted,

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Dated: 6/28/02

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims

1. (Amended) An exterior rear view mirror for a vehicle comprising a base for mounting on a vehicle body, a housing pivotally mounted on the base for angular movement about a first pivot axis, a reflective member mounted in the housing, an electric motor having an output shaft [arrange] selectively operable to cause angular movement of the housing about the first pivot axis at a first discrete speed and at a second discrete speed, and a controller adapted to control the electric motor so as to selectively drive the housing about the first axis either at [a] the first speed or at [a] the second speed which is faster than the first speed.